

**REMARKS**

Reconsideration and allowance of the subject application are respectfully requested.

Upon entry of this Amendment, claims 1-13 pending in the application. Applicant respectfully submits that the pending claims define patentable subject matter.

Claims 9 and 10 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement because the Examiner asserts that "[t]he specification does not describe how the mobile station information has already been communicated to the network in the context of a downlink transfer of data already set up." Applicant respectfully submits that the specification is fully enabling with regard to the subject matter of claim 9. In particular, the Examiner is directed to page 12, line 21 to page 13, line 12 of the specification (the third embodiment) which describes the subject matter of claim 9 with reference to FIG. 4.

Moreover, one of ordinary skill in the art of GPRS communications would readily know and understand how a downlink transfer of data is set up between the network and the mobile station, i.e., a downlink temporary backflow (TBF), and how identity information of the mobile station is provided to the network during the set up procedure. It is well settled that "[the applicant] may begin at the point where his invention begins, and describe what he has made that is new and what it replaces that is old. That which is common and well known is as if it were written out in the patent and delineated in the drawings." *Webster Loom Co. v. Higgins et al.*, 105 U.S. 580, 586 (1882). It is also well settled that a patent application need not include in the Specification that which is already known to and available to the public. See *Paperless Accounting v. Bay Area Rapid*

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*Transit System*, 231 U.S.P.Q. 649, 653 (Fed. Cir. 1989), citing *In re Howarth*, 210 U.S.P.Q. 689 (C.C.P.A. 1981).

Accordingly, the Examiner is respectfully requested to withdraw the § 112, first paragraph, rejection.

Claims 1-13 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. By this Amendment, Applicant has amended the claims to improve clarity. Accordingly, the Examiner is respectfully requested to remove the § 112, second paragraph, rejection.

Claims 1-3, 11 and 13 are rejected under 35 U.S.C. § 102(e) as being anticipated by Alperovich et al. (U.S. Patent No. 6,249,676; hereafter “Alperovich”). Claims 4-10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Alperovich in view of Lintulampi et al. (U.S. Patent No. 6,747,962; hereafter “Lintulampi”). Claim 12 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Alperovich in view of Hjelm et al. (U.S. Patent No. 5,978,368; hereafter “Hjelm”). Applicant respectfully submits that the claimed invention would not have been anticipated by Alperovich or rendered obvious in view of Alperovich, alone or in combination with Lintulampi and/or Hjelm.

With regard to independent claims 1 and 11, the Examiner cites FIG. 7 of Alperovich for allegedly disclosing all of the features of the claims. In particular, the Examiner asserts that Alperovich “teaches a system and method where a MCS/VLR fetches classmark information (radio access capacity information) from a mobile subscriber if the MSC/VLR does not already hav[e] the subscriber data (mobile station identity information) that the MSC/VLR fetched from the HLR.” Thus, it appears that the Examiner has construed the “information” in the limitation

“if it does not already hold such/the information” as being the “mobile station identity information” rather than the “radio access capacity information” as is described throughout the specification.

Alperovich discloses a telecommunications system and method for restricting optimization of calls between mobile terminals within a satellite network to allow implementation of supplementary services. Either the network operator or the mobile subscriber can decide whether supplementary services or optimization of calls between mobile subscribers in a satellite network has priority. Prior to placing a call, the mobile subscriber can enter a service code on the mobile terminal indicating that the call should or should not be optimized, depending upon the default parameters of the service provider. Alternatively, the network operator can determine whether a conflict exists between optimization and supplementary services, and if one exists, forego optimization in favor of the supplementary services.

FIG. 7 of Alperovich disclose that a serving Mobile Services Center (MSC)/Visitor Location Register (VLR) fetches, from a home location register (HLR), subscriber data containing supplementary services (i.e., call waiting, multi-party calling, call transferring, and/or Short Message Service) for a called mobile terminal (MS) or the serving MSC/VLR can fetch classmark information from a calling MS and the called MS.

Thus, Alperovich does not teach or suggest “determining, from mobile station identity information communicated to the network, whether the network already holds **radio access capacity information** relating to the mobile station, and if it is determined that the network does not already hold the **radio access capacity information**”, requesting the mobile station to

communicate the radio access capacity information to the network”, as recited in claim 1 and similarly recited in claims 11 and 13. That is, nowhere does Alperovich teach or suggest that the subscriber data containing supplementary services fetched from the HLR is radio access capacity information. Instead, the subscriber data is information regarding supplementary services such as call waiting, multi-party calling, call transferring, and/or Short Message Service and associated priority indicators.

Accordingly, Applicant respectfully submits that independent claims 1, 11 and 13, as well as dependent claims 2-10 and 12, should be allowable because the cited references, alone or in combination, do not teach all of the features of the claims.

With regard to dependent claims 4-10, the Examiner concedes that Alperovich does not disclose that:

(1) the network requests the mobile station to communicate said radio access capacity information to the network in a message (a PACKET UPLINK ACK/NACK message) acknowledging data received in the uplink direction, as required by claims 5, 6 and 9; and

(2) the network requests the mobile station to communicate the radio access capacity information to it in an uplink radio resource assignment message (a PACKET UPLINK ASSIGNMENT message), as required by claims 7 and 8.

In view of the conceded deficiencies of Alperovich, the Examiner cites Lintulampi for “teach[ing] a GPRS system with PACKET UPLINK ACK/NACK message and a PACKET UPLINK ASSIGNMENT message containing multiple fields”. Further, the Examiner asserts that it would have been obvious to modify Alperovich to include the features of claims 4-10

“because the fetch request could be sent in a field in either the PACKET UPLINK ACK/NACK message and a PACKET UPLINK ASSIGNMENT message instead of creating an entirely new message.”

However, Applicant respectfully submits that one of ordinary skill in the art would not have been motivated to modify Alperovich based on the teachings of Lintulampi to produce the claimed invention. It is well settled that “[t]o support the conclusion that the claimed invention is directed to obvious subject matter, either references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the reference.” *Ex parte Clapp* 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). In the present case, the Examiner has not provided any objective reasoning why one of ordinary skill in the art would have been motivated to modify Alperovich or pointed out any portion of Lintulampi which suggests the desirability of modifying Alperovich’s teachings.

The mere fact that Lintulampi discusses PACKET UPLINK ACK/NACK and PACKET UPLINK ASSIGNMENT messages (which are well known in the art), does not provide any motivation to include a request to communicate radio access capacity information in a PACKET UPLINK ACK/NACK message, and include a request to communicate the radio access capacity information in a PACKET UPLINK ASSIGNMENT message. Further, the Examiner’s proposed motivation for modifying Alperovich (“instead of creating an entirely new message”) is

not supported by the teachings of the prior art.<sup>2</sup> Nor does the Examiner provide any explanation regarding how Alperovich's disclosed method/system could be modified to utilize the claimed types of messages (which would clearly require a significant redesign to Alperovich's method/system).

Accordingly, Applicant respectfully submits that claims 4-10 recite additional features which render the claims patentable over the prior art of record.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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<sup>2</sup> The characterization of certain limitations or parameters as obvious does not make the claimed invention, considered as a whole, obvious. It is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

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Respectfully submitted,



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WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

Date: February 21, 2006

Attorney Docket No.: Q67767